



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

T

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,149	09/26/2003	Selena Chan	070702007620	6083
7590	10/18/2006		EXAMINER	
Raj S. Dave Morrison & Foerster LLP 1650 Tysons Blvd., Suite 300 McLean, VA 22102				WILDER, CYNTHIA B
		ART UNIT		PAPER NUMBER
		1637		

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/672,149	CHAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Cynthia B. Wilder, Ph.D.	1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 August 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 26-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. Applicant's amendment filed 8/14/2006 is acknowledged and has been entered. Claims 26 have been amended. Claims 26-34 have been added. All of the arguments have been thoroughly reviewed and considered but are not found persuasive for the reasons discussed below. Any rejection not reiterated in this action has been withdrawn as being obviated by the amendment of the claims.

**This action is made FINAL.**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Previous Rejections***

3. The double patenting rejection against the claims are maintained and discussed below. The prior art rejection under 35 USC 102(e) is maintained and discussed below.

4. **Issue:** **Provisional double patenting in view of 10/099,287 and 11/270,211**

**Applicant's Traversal**

Applicant traverses the rejection on the following ground: Applicant states that these rejections are respectfully traversed. Applicant asserts that as these rejections are not provisional, Applicants are not required under the law to respond to these rejections.

**Examiner's Response**

MPEP 804 states that "[T]he "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications." Since this application is not in condition for

allowance and the double patenting rejection is not the only outstanding issue in this case, the provisional double patenting rejections are being maintained by the Examiner.

5.     Issue:     Claims 26-33 are rejected under 35 USC 102(e) as being anticipated by Kneipp et al.

**Applicant's traversal**

I.     Applicant traverses the rejection on the following grounds: Applicant states that a careful reading of Kneipp III shows that claims 173-179 are nowhere supported in the specification of Kneipp III. Applicant states that therefore, the effective filing date of claims 173-179 of Kneipp III is the filing date of Kneipp III, which is November 26, 2003. Applicant states that therefore, the reliance on the disclosure of claims 173-179 of Kneipp III to reject claims 26-33 is incorrect. Applicants state that they have carefully researched the file history of Kneipp III. Applicant states that Kneipp, filed on November 26, 2003 is a continuation of serial no. 10/054,727, filed January 22, 2002, now abandoned, which is a continuation of serial number 09/063,741 filed on April 21, 1998, now abandoned. Applicant asserts that on the other hand, the pending application is a continuation-in-part of serial no. 10/108,128 filed March 26, 2002 and published on October 2, 2003. Applicants state that original claim 26 of the pending application was recited in substantially identical form as claim 20 of the 10/108,128 application. Applicant states that in fact, it appears that the patentee of Kneipp III drafted claims 173-179 and filed Kneipp III on November 26, 2003 simply to create artificial prior art against the pending application when none really exists. Applicant compares the claim 173 of Kneipp III with claim 20 of the application '128 and states that it becomes evident that the intention of the patentee of Kneipp III was to substantially copy claim 20 of the '128 application. Applicant states that if

the Examiner perform a quick computerize search of Kneipp II using the recited terms, the Examiner will find that none of these terms are disclosed anywhere in Kneipp II. Applicant states that after filing the application of Kneipp III, the patentee of Kneipp III filed a preliminary amendment on September 29, 2004. Applicant in this preliminary amendment, the patentee of Kneipp III replaced all prior version and listing, of the claims with the claims shown in Exhibit III. Applicant states that on June 1, 2005, the Examiner of Kneipp III issued a restriction requirement restricting the claims into multiple groups. Applicant states that the patentee of Kneipp III filed as second preliminary amendment on August 25, 2005, canceling apparatus claims 173-178. Applicant states that in short, apparatus claims 173-178, which are not supported or enable by the disclosure of Kneipp I, have also not been tested by the USPTO for appropriate support and enablement in the disclosure of Kneipp I. Applicant respectfully submit that claims 173-178 of Kneipp III were intentionally added and later canceled in Kneipp III to create artificial prior art against the apparatus claims of the pending application. In conclusion, Applicant asserts that the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and pass this application to issue.

***Examiner's Response***

II. All of the arguments have been thoroughly reviewed and considered but are not found persuasive for the reasons that follow: In regards to Applicant's arguments that the filed Kneipp III on November 26, 2003 was created as artificial prior art against the pending application because the claims of Kneipp III substantially copy the claim 20 of the '128 application, it is noted that neither Applicant nor the Patent office through prosecution of Kneipp III have

Art Unit: 1637

establish that Kneipp III is not prior art against the claims of the instant invention. While it is noted that the claims 173-178 of Kneipp III have been canceled during prosecution of the application, Applicant is reminded that the claims were canceled based on a restriction requirement and not based on non-enablement. Such cancellation is not an admission that the claims are not enabled as prior art.

In regards to Applicant's arguments that a search of Kneipp (10/054,727 and 2005/0003376) will reveal that Kneipp is not enabled for the invention claimed in the claims 173-178, it is firstly noted that the application 10/054,727 does not belong to Kneipp but is drawn to a "New Process" invented by Ronald James Ogilvie (2003/0166704). Secondly, in regards to the published application 2005/0003376, which is invented by Kneipp et al, it is noted that Kneipp makes references to the invention encompassing a method and apparatus at paragraph 0091, (see also pages 3-5). Kneipp et al compares his method and apparatus to other methods and apparatuses of the prior art at paragraph 0010 and 0011. Kneipp throughout '376 discuss surfaces used in the method and apparatus and Raman signaling.

In response to Applicant's arguments that Kneipp intentionally added and later canceled the claims to create artificial prior art against the apparatus claims, it is again noted that such allegation has not been adequately proven by Applicant or the Patent Office through prosecution. Applicant's arguments are not sufficient to overcome the prior art rejection. Accordingly, the rejections are maintained.

### New Grounds of Rejection

#### THE NEW GROUNDS OF REJECTIONS WERE NECESSITATED BY APPLICANT'S AMENDEMENT OF THE CLAIMS:

##### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - (a) Claim 34 is indefinite at the recitation of "substantially throughout a cross-sectional area of the second channel" because Applicant has not provide a definition as to what constitutes "*a substantial amount of aggregates*" within a channel, especially a cross sectional area of a channel. Thus it is unclear what is meant by "substantially" in reference to the aggregates. Clarification is required.

##### *Conclusion*

8. No claims are allowed. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

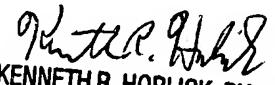
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cbw

  
KENNETH R. HORLICK, PH.D  
PRIMARY EXAMINER

10/12/06